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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/682,176	10/09/2003	Erik J. Bartone	70406/2-CON	7312

7590 02/24/2005

David Lowry
Brown Rudnick Freed & Gesmer
One Financial Center, 18th Floor
Box IP
Boston, MA 02111

EXAMINER

HOLLOWAY III, EDWIN C

ART UNIT PAPER NUMBER

2635

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/682,176

Applicant(s)

BARTONE ET AL.

Examiner

Edwin C. Holloway, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2003.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-20 is/are rejected.
7) ☒ Claim(s) 2,10 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 09 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3-15-04.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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EXAMINER'S RESPONSE

1. In response to the application filed 7-13-01, the application has been examined. The examiner has considered the presentation of claims in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

Claim Objections

2. Claims 2 and 10 are objected to because of the following informalities: Claim 2 does not end in a period. Claim 10 recites "said at least on device controller" without previous inclusion of this term in claim 9. It is suggested that "at least on" be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 102 & 103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the

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invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered

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therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 12-20 are rejected under 35 U.S.C. 102(b) as being anticipated by McNamara (US 5818725).

Regarding claim 12, McNamara discloses a system for controlling energy distribution to energy consumers (col. 1 lines 35-43) comprising: a centralized data center (10); a plurality of device controllers in communication with said centralized data center (12,13); a plurality of parameter measuring devices in communication with said centralized data center (12,13); wherein said centralized data center reads parameters from said parameter measuring devices, computes control signals according to efficient power control algorithms operating on said parameters and communicates said control signals to said device controllers. See fig. 1, col. 2 lines 32-42 and col. 3 lines 34-63.

Regarding claim 13, McNamara discloses wherein efficient power control algorithms compute said control signals to minimize power consumption by computing cost optimized power distribution over time in col. 2 lines 32-40.

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Regarding claim 14, McNamara discloses wherein said parameters are communicated in real time and wherein said control signals are constantly re-computed according to changes in said parameters in col. 2 lines 32-40.

Regarding claim 15, McNamara discloses wherein said parameters include electrical power levels in col. 2 lines 32-40.

Regarding claims 16-17, the monitoring and control 25 of McNamara is proximate (in the same facility location) to loads 26,28) in fig. 2a and col. 4.

Regarding claim 18, McNamara discloses further comprising facility controllers (22) in communication between said device controllers (22, home network) and said centralized data center (10,14,22) in col. 3 line 64- col. 4 line 1.

Regarding claims 19 and 20, McNamara discloses wherein said centralized data center (10 and said device controllers (22) are in wireless communication (14) in col. 5 lines 34-36.

7. Claims 1-2, 5-8 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis (US 5576700) in combination with McNamara (US 5818725).

Regarding claim 1, Davis discloses a method for monitoring and controlling power usage among a plurality of facilities (fig. 1, col. 7), comprising: providing a remotely controllable

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power control device (32) on at least one power consuming device (24) at each facility (20); remotely monitoring power usage at processing center (28) and command center (26) can control remotely controllable power control devices (32); and activating and deactivating said power consuming devices (24) by said remotely controllable power control devices (32) from said distribution network (22), based on said remotely monitored power usage among said plurality of facilities (28). See col. 7 line 30 - col. 8 line 36. Davis does not expressly disclose remote monitoring of power usage at each facility and activating/deactivating power consumption devices from a single location.

McNamara discloses remotely monitoring power usage at each facility from one location (10), wherein said one location can control said remotely controllable power control devices (12,13) in col. 3 lines 34-48; and activating and deactivating said power consuming devices by said remotely controllable power control devices from said one location (10), based on said remotely monitored power usage among said plurality of facilities in col. 2 lines 33-42.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the techniques of McNamara discussed above in the invention of

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Davis, using one location for activating and deactivating power consumption devices by remotely controllable power control devices, based on remotely controlled monitored power usage among plurality of facilities that would have allowed optimization of power consumption for a power distribution network in col. 3 lines 45-48 of McNamara.

Regarding claim 2, McNamara discloses wherein said steps of remotely monitoring power usage and activating and deactivating are performed over a wireless communication network (14) in col. 5 lines 34-36.

Regarding claim 5, McNamara discloses wherein said step of monitoring power usage is performed by current sensing (70) in fig. 2 and col. 10 lines 32-51.

Regarding claim 7, McNamara discloses wherein said step of monitoring power usage is performed by voltage sensing (70) in fig. 2 and col. 11 lines 1-16.

Regarding claims 6 and 8, wherein an electric utility meter at one of said facilities is not affected by said monitoring of power usage at said facility is considered inherent because a utility meter at the facility to measure power for local observation is not affected remote monitoring and no such affect is described in the references.

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Regarding claim 9, Davis discloses a system for monitoring and controlling power usage among a plurality of facilities, comprising: a device controller (32) coupled to at least one power consuming device (24) at each facility (20), said device controller to control said at least one power consuming device (32,24); a power measurement device (33) within each facility (20), to measure power consumption by power consuming devices within said facility. See col. 7 line 30 - col. 8 line 20. Davis does not expressly disclose the communication network and central location in communication with the network as recited in claim 9.

McNamara discloses a communications network (14), in communication with said device controllers and said power measurement devices (12, 22 home network); a central location (10), in communication with said communications network (14), to remotely monitor power usage at each facility as measured by said power measurement device (22 home network); wherein said central location communicates with said device controllers over said communications network in order to individually control said at least one power consuming device at each facility. See col. 3 lines 42-48.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the

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techniques of McNamara discussed above in the invention of Davis with the central location communicating with the device controllers at each facility of the communication network to control at least one power consuming device at the facility to optimize power consumption as recited in col. 3 lines 45-48 of McNamara.

Regarding claim 10, Davis discloses wherein said at least one device controller (32) controls said power consuming device (24) by activating and deactivating said power consuming device in col. 7 lines 38-58.

Regarding claim 11, Davis discloses wherein said system monitors and controls power usage in order to limit power consumption by said plurality of facilities in col. 3 lines 45-48.

8. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis (US 5576700) in combination with McNamara (US 5818725) as applied above and further in view of Kelly (US 6088659). Kelly discloses a plurality of two way RF nodes in a wireless network for monitoring and controlling power usage including activating/deactivating power consuming devices over the wireless network. See col. 5. The nodes of Kelly communicate both with other nodes (public access RF networks, etc.) and to communicate with facilities for power control in cols. 5-6 and 13. Regarding claims 3-4, it would have been

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obvious to one of ordinary skill in the art at the time the invention was made to have included this wireless monitoring and control network of Kelly in the combination applied above in order to avoid the time and cost of installing a hardwired network for monitoring and control.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6633823.

Although the conflicting claims are not identical, they are not patentably distinct from each other claims 1-20 of the instant application are generally broader than the claims in your patent. Broader claims in a later application constitute obvious double

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patenting of narrow claims in an issued patent. See *In re Van Ornum and Stang*, 214, USPQ 761, 766, and 767 (CCPA) (the court sustained an obvious double patenting rejection of generic claims in a continuation application over narrower species claims in an issued patent); *In re Vogel*, 164 USPQ 619, 622, and 623 (CCPA 1970) (generic application claim specifying "meat" is obvious double patenting of narrow patent claim specifying "pork").

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hildebrand (US 5640153) discloses an energy utilization control system.

CONTACT INFORMATION

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact an Electronic Business Center (EBC) representatives at 703-305-3028 or toll free at 866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at ebc@uspto.gov. The Patent EBC is a complete customer service center that supports all Patent e-business products and service applications. Additional information is available on the Patent EBC Web site at <http://www.uspto.gov/ebc/index.html>.

Any inquiry of a general nature should be directed to the Technology Center 2600 receptionist at (571) 272-2600.


Facsimile submissions may be sent via fax number (703) 872-9306 to customer service for entry by technical support staff.

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Questions regarding fax submissions should be directed to customer service voice line (703) 306-0377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (571) 272-3058. The examiner can normally be reached on M-F (8:30-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571) 272-3068.

EH
2/22/05


EDWIN C. HOLLOWAY, III
PRIMARY EXAMINER
ART UNIT 2635

MICHAEL HORABIK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

